

**REMARKS**

Claims 1-5, 7-16, 25-27, 30-31, and 33-34 remain in the application for further prosecution.

**I. THE 35 U.S.C. § 112, FIRST PARAGRAPH REJECTION**

Claims 33-34 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The track was not described as having a trapezoidal cross-sectional profile, mating profile, or being cantilevered in the second position. This rejection is traversed.

An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed”. *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). In determining whether a written description issue exists, the fundamental factual inquiry is whether the specification conveys with reasonably clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement (*see, e.g.*, MPEP § 2163.01). As to the Examiner’s allegation that “[t]he track was not described as having a trapezoidal cross-sectional profile,” the Examiner is invited to examine FIG. 8 of the Applicant’s

specification. In the example depicted in FIG. 8, the track upon which each of the plurality of individually moveable platforms is disposed to move is shown to have a trapezoidal cross-sectional profile and the moveable platform is shown to comprise a mating profile (e.g., complementary to the trapezoidal shape of the moveable platform). In the example depicted in FIG. 7, the track (not numbered) is shown, adjacent to and on the right side of the member identified by reference numeral 506, to be stationary and attached to the base 506. When the movable platform 504a is extended to the second position relative to this stationary track, it is substantially cantilevered relative to the track. Accordingly, Applicant submits that the application complies with the written description requirement of 35 U.S.C. § 112, 1<sup>st</sup> paragraph.

Moreover, a description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. *See, e.g., In re Marzochhi*, 439 F.2d 220, 224 (CCPA 1971). Applicant submits that the 35 U.S.C. § 112, 1<sup>st</sup> paragraph rejection is improper for at least this reason and must be withdrawn.

## II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

Claims 33-34 were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically asserted that, as to claim 33, it was “unclear what a mating profile denotes” and, as to claim 34, it was “unclear how the platform is cantilevered relative to the track.” This rejection is traversed.

Definiteness of claim language must be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one

of ordinary skill in the art at the time the invention was made. *See, e.g., In re Moore*, 439 F.2d 1232, 1235; 169 USPQ 236, 238 (CCPA 1971). The essential inquiry is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity.

A “mating profile” is, in its conventional sense, two parts having a shape permitting the parts to matingly engage one another or are complementary to one another. For example, a male connector and a female connector would be said to have a mating profile. The example of FIG. 8 of the Applicant’s specification shows a moveable platform having a trapezoidal cross-sectional profile and an underlying tracking also having a corresponding, or mating, trapezoidal cross-sectional profile. As to “cantilevered,” as noted above, in the example depicted in FIG. 7, the track (not numbered) is shown, adjacent to and on the right side of the member identified by reference numeral 506, to be stationary and attached to the base 506. When the movable platform 504a is extended to the second position relative to this stationary track, it is substantially cantilevered relative to the track.

In view of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made, Applicant submits that claims 33 and 34 set out and circumscribe the recited subject matter with at least a reasonable degree of clarity.

## II. THE 35 U.S.C. § 102 REJECTION

Claims 1-2, and 4 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hino *et al.* (US 2002/0162724) (“Hino”). Reconsideration and withdrawal of this rejection is requested.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must

be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Examiner alleges that Hino discloses a “dampening mechanism (See FIG. 4 below, C and 122a); coin receptacle station (120); first end (See FIG. 4 below, C); housing (110); second end (See FIG. 4 below, Back Side (opposite Front Side) of 122a)” (see Office Action, page 6). Thus, the asserted “dampening mechanism” is simply a front wall 122a of the drawer 122 (see par. [0136]). The front wall 122a serves to stop movement of the drawer 122 at a predefined point upon insertion of the drawer into the coin processing unit 110 housing.

Claim 1 has been amended to clarify the claim to make explicit that which is already implicit to recite a coin processing device comprising, *inter alia*, “a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle between the first position and the second position” (emphasis added). Even as construed by the Examiner, the drawer 122a and backstop C, do not “exert a damping force” on the storage unit 120 during movement of the storage unit between the first position and the second position, wherein the storage unit is “disposed entirely within the housing for receiving coins when in the first position” and wherein the storage unit is “extending out of the housing when in the second position.” The front wall 122a and backstop C, even when taken in combination, are not capable of, nor do they disclose or suggest, the recited element. It is further noted that, even to the extent that the Examiner’s assertion that front wall 122a and backstop C were accepted to constitute a dampening mechanism, which it is not, such “dampening mechanism” does not operate ***between*** a first position (the storage unit is disposed entirely within the housing) and a second position (the storage unit is extending out of the housing). The term “between” cannot be unreasonably construed, nor can it be ignored. “All words in a claim must

be considered in judging the patentability of that claim against the prior art" (*see In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995)(*stating* "[w]hen evaluating the scope of a claim, every limitation in the claim must be considered"). Further, Applicant notes that "proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation." *See, e.g., Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999); *accord Phillips v. AWH Corp.*, 415 F.3d 1303, 1313-14; 75 USPQ2d 1321, 1326-27 (Fed. Cir. 2005)(*en banc*). Thus, the term "between" cannot be interpreted in isolation, bereft of the context of the first position and the second position.

In view of at least the foregoing remarks, Applicant respectfully submits that claims 1-2 and 4 are not anticipated by Hino under 35 U.S.C. § 102(e) as Hino fails to identically teach each and every element of these claims.

### III. THE 35 U.S.C. § 103 REJECTION OF CLAIM 3

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Jones *et al.* (US 6,318,537) ("Jones"). Reconsideration and withdrawal of this rejection is requested.

Claim 3 recites coin processing device comprising, *inter alia*, "a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle between the first position and the second position" (emphasis added). As noted above, even as Hino is construed by the Examiner, the drawer 122a and backstop C, do not "exert a damping force" on the storage unit 120 during movement of the storage unit between the first position and the second position, wherein the storage unit is "disposed entirely within the housing for receiving coins when in the first position" and wherein the storage unit is "extending

out of the housing when in the second position.” The front wall 122a and backstop C, even when taken in combination, are not capable of, nor do they disclose or suggest, the recited element in view of any reasonable construction of such element.

Accordingly, the combination of Hino and Jones fails to identically teach or suggest each and every element of claim 3 and, in view of at least the foregoing remarks, Applicant respectfully submits that claim 3 is no unpatentable under 35 U.S.C. § 103(a) in view of Hino and Jones.

#### **IV. THE 35 U.S.C. § 103 REJECTION OF CLAIMS 5, 7-9, 14-16, 25-27, AND 33-34**

Claims 5, 7-9, 14-16, 25-27, and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner (US 4,450,968) (“Muellner”). Reconsideration and withdrawal of this rejection is requested.

##### **A. CLAIMS 5-16**

Claims 5-16 recite, *inter alia*, “a coin receptacle station disposed within the housing for holding a plurality of coin receptacles, the coin receptacle station including a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first position and a second position, each moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first position, each moveable platform extending out of the housing when in the second position.”

Hino fails to disclose, for example, a “coin receptacle station including *a plurality of individually moveable platforms* each having at least one coin receptacle disposed thereon” (emphasis added). Instead, Hino show only a single drawer 122.

Further, the Examiner's statement of rejection seems to imply that the plurality of individually moveable platforms limitation is satisfied by "moveable platforms (122)". However, the Examiner has failed to address the recited limitation that the coin receptacle station includes "a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon."

The Examiner now argues, in reliance upon MPEP § 2144.04(VI)(B) and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) cited therein, that individually moveable platforms in Hino would be a mere duplication of parts and, therefore, would have been obvious to one of ordinary skill in the art (sentence bridging pages 6-7 of Office Action and second to last paragraph on page 7 of Office Action). The court in *In re Harza* stated that the only difference between the reference's structure for sealing concrete and that of Harza's claim 1 was that the reference's structure had only a single rib (i.e., arm) on each side of a web, whereas the claim required a plurality of such ribs. See *In re Harza*, 274 F.2d at 671, 124 USPQ at 380. The court stated that "[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here." *Id.*

However, the Examiner does not compare the facts in *In re Harza* with those in the present case and explain why, based upon this comparison, the legal conclusion in the present case should be the same as that in *In re Harza*. Instead, the examiner relies upon *In re Harza* as establishing a *per se* rule that duplication of parts is obvious. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the

claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner must, and has failed to, explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. For at least the above reasons Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness of claims 5, 7-9 and 14-16 under 35 U.S.C. § 103(a).

#### B. CLAIMS 14-16

Further, specifically as to claims 14-16, for example, the Examiner states that Hino discloses a “door (122a)” with an “open position (FIG. 4)” and a “closed position (FIG. 2).”

The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation.’*” *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)(*italics added*). The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized the “broadest reasonable interpretation” standard, stating that:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the

invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).

415 F.3d at 1316, 75 USPQ2d at 1329. See also *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

The claims, of course, do not stand alone, but are rather part of “a fully integrated written instrument,” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). For that reason, claims “must be read in view of the specification, of which they are a part.” *Id.* at 979.

In his “Response to Arguments,” the Examiner states that “[t]he wall is a door since it is a ‘movable panel (122a in FIG. 2 and 4) for closing off an entrance (See FIG. 4, opening near 116)”” (*citing* Webster’s II Dictionary, Office Edition, 3<sup>rd</sup> Ed., Houghton Mifflin Company, 2005). The Examiner’s interpretation of this claim notably omit any mention of Applicant’s specification and appear not to be viewed in light of the specification. It is submitted, therefore, that one skilled in the art would not have reasonably interpreted “door” in the manner asserted by the Examiner. It is, incidentally, noted that the more expansive Webster’s II New College Dictionary (Houghton Mifflin Company, 1995) defines “door” as a “movable structure for closing off an entrance, *typically consisting of a panel that swings on hinges, slides, or rotates*” (emphasis added). Contextually, as presented by the Examiner, the term “door” would appear to encompass a hood of a car, a tent flap, or a window, or even a warning sign disposed prominently in a hallway, items which are not typically associated with the terminology “door.” Such a reading would not objectively appear reasonable.

Hino fails to show a housing comprising “a door moveable between an open position and a closed position, the door permitting a moveable platform to move from the first position to the second position when the door is in the open position.” The front wall 122a has itself neither an open position nor a closed position and does not permit the moveable drawer to move from a first position to a second position “when the door is in the open position.”

For at least the above reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness of claims 14 and 15 under 35 U.S.C. § 103(a) in view of Hino and Muellner.

#### C. CLAIMS 25-27

Claims 25-26 recite, *inter alia*, a “method for processing coins with a coin processing machine comprising a housing, a coin sorting unit disposed within the housing, and a plurality of moveable coin receptacle platforms each for holding at least one coin receptacle, the coin receptacle platforms each being independently moveable between a first position and a second position, each coin receptacle platform being disposed entirely within the housing for receiving coins when in the first position, each coin receptacle platform extending out of the housing when in the second position, the method comprising . . . moving one of the plurality of moveable coin receptacle platforms from the first position to the second position for accessing the coin receptacles.”

Claim 27 recites a coin processing device comprising a housing, a coin sorting unit disposed within the housing, the coin sorting unit being configured to sort and discharge coins according to denomination and “a coin receptacle area comprising a coin receptacle station disposed within the housing for holding a plurality of coin receptacles each for receiving discharged coins of a single denomination, the coin receptacle station including a plurality of

individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first position and a second position, each moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first position, each moveable platform extending out of the housing when in the second position.”

The Applicant’s remarks, above, concerning claims 5-16, particularly those directed to the Examiner’s inappropriate use of *In re Harza* and improper reliance on *per se* rules of obviousness are incorporated herein by reference, but are otherwise omitted for brevity. The Examiner is kindly referred to the remarks in Section IV.A, above.

For at least the reasons noted above, Hino fails to disclose, for example, “a plurality of moveable coin receptacle platforms each for holding at least one coin receptacle, the coin receptacle platforms each being independently moveable between a first position and a second position,” and, correspondingly, an act of “moving one of the plurality of moveable coin receptacle platforms from the first position to the second position for accessing the coin receptacles” (claims 25-26). Similarly, Hino fails to disclose or suggest a “coin receptacle station including a plurality of individually moveable platforms,” as recited in claims 27-28. Instead, Hino shows only a single drawer 122. The Examiner’s statement of rejection incorrectly attributes to Hino’s disclosure “coin-receptacle platforms” or “moveable platforms” where only a single drawer 122 is disclosed.

Further, as to claim 26, the Examiner states that Hino discloses “opening a door (122a) of the housing prior to moving the one of the coin-receptacle platforms from the first position to the second position” (*citing* par. [0131]). As noted above, Hino fails to show a housing comprising

a door moveable between an open position and a closed position, the door permitting a moveable platform to move from the first position to the second position when the door is in the open position. The “front wall 122a” cannot be reasonably be interpreted as a door, as it is a wall having neither an open position nor a closed position. The front wall 122a does not permit the moveable drawer to move from a first position to a second position when the door is in the open position. Stated differently, Hino cannot teach the recited subject matter, even under the Examiner’s unduly broad interpretation since the alleged “door (122a)” cannot be opened prior to moving the drawer (*i.e.*, the alleged coin-receptacle platform) from the first position to the second position since the front wall 122a is an integral part of the drawer 122 and cannot be moved prior to movement of the drawer itself.

**V. THE 35 U.S.C. § 103 REJECTION OF CLAIMS 10, 12-13 AND 30 AND THE 35 U.S.C. § 103 REJECTION OF CLAIMS 11 AND 31**

Claims 10, 12-13, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner and further in view of Jones, *et al.* (US 6,318,537) (“Jones”). Claims 11 and 31 were likewise rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner and further in view of Jones. Reconsideration and withdrawal of this rejection is requested.

Hino is acknowledged not to disclose a plurality of individual moveable platforms, a track, coin bags, or coin holders. The Examiner asserts that “[i]t would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Hino and include a plurality of individual movable platforms since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” (emphasis in original)(*citing* MPEP § 2144.04(VI)(B)). The Applicant’s remarks, above, concerning claims

5-16, particularly those directed to the Examiner's inappropriate use of MPEP § 2144.04(VI)(B)) and *In re Harza* and improper reliance on *per se* rules of obviousness, are incorporated herein by reference, but are otherwise omitted for brevity. The Examiner is kindly referred to the remarks in Section IV.A, above.

Claims 10-13 recite a coin processing machine, comprising a coin receptacle station disposed within the housing for holding a plurality of coin receptacles, the coin receptacle station including a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first position and a second position, each moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first position, each moveable platform extending out of the housing when in the second position. The applied combination of Hino, Muellner, and Jones has not been shown to teach or suggest this combination of features. Accordingly, for at least this reason, Applicant respectfully submits that the Examiner has failed to set forth a *prima facie* case of obviousness of claims 10-13 under 35 U.S.C. § 103(a).

Claims 30-31 similarly recite a coin processing device comprising "a coin receptacle area comprising a coin receptacle station disposed within the housing for holding a plurality of coin receptacles each for receiving discharged coins of a single denomination, the coin receptacle station including a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first position and a second position, each moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first position, each moveable platform extending out of the housing when in the second position." For at least

the above-noted reason, Applicant respectfully submits that the Examiner has failed to set forth a *prima facie* case of obviousness of claims 30-31 under 35 U.S.C. § 103(a).

Further, Applicant submits that the asserted *prima facie* case of obviousness fails for additional reasons. The Examiner asserts that Muellner “shows a similar device having a track (24) for the purpose of receiving and capturing the casters (column 2, lines 57-66)” and that “[t]herefore, it would have been obvious . . . to modify Hino as taught by Muellner and include Muellner’s similar device having a track for the purpose of receiving and capturing the casters.” The “Nestable Cart Anti-Reversing Apparatus” disclosed by Muellner teaches utilization of an anti-reversing tab (54) disposed adjacent a wheel (42) of a nestable cart (14) for transporting baggage, packages, or groceries (col. 1, lines 5-15), to prevent customers from inserting the cart backwards in an island (col. 2, lines 1-27) in such a way that other customers who have rented the cart for a service charge would be prevented from receiving their award money for returning the cart (*see* cols. 1-2). Specifically, the anti-reversing tab (54) prevents a user of the cart from inserting the cart backwards, which would thereby prevent other people from returning their carts and correspondingly prevent those subsequent users from receiving their deposit. The track 24 is disposed on one side of the vending island 10 to receive the wheel of one side of the cart with the supporting axle 36 riding in the slot 28 (col. 4, lines 65-68). In order to preclude capture of a cart in a direction opposite to that intended, the anti-reversing means 54 is provided which will not be received in the slot 28. The purpose of the track 24 in Muellner is therefore to provide a mechanism by which the carts may be individually dispensed and received following use.

Obviousness requires a teaching that all elements of the claimed invention are found in the prior art and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” *KSR Int'l Co. v.*

*Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007)(citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)); see also *Ex parte Smith*, 83 USPQ2d 1509, 1515 (Bd. Pat. App. & Int. 2007). The mere fact that references can be combined or modified does not itself render the resultant combination obvious.

Hino mentions no deficiencies or problems associated with the use of casters 122b for coin drawers and Muellner relates to wheels not casters. Muellner discloses no generally applicability of the disclosed subject matter to anything other than carts used for baggage, packages and groceries. There is no evidence of record supporting the proffered combination, nor has any articulated reasoning with some rational underpinning been advanced in support the legal conclusion of obviousness. Instead, the Examiner merely sets forth a generalized assertion. The Examiner’s burden to set forth a *prima facie* case of obviousness has not been discharged, as broad conclusory statements, standing alone, are not “evidence” supportive of a *prima facie* showing. See *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

Reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of claims 10, 12-13 and 30-31 is therefore requested at least upon the above-noted grounds.

It is again submitted that Muellner is non-analogous art. To rely upon a reference as a basis for rejection, the reference must either be in the field of the Applicant’s invention or, if not, *must be reasonably pertinent to the particular problem with which the inventor was concerned*. See *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). The Examiner correctly notes that the inquiry

relative to *In re Oetiker* focuses on the problem with which the inventor(s)/applicant(s) is concerned. However, in the Examiner's "Response to Arguments," the Examiner incorrectly states that "[i]n this case, the structure of the track (24) in Muellner is pertinent to the problem with which the applicant was concerned, namely to move each moveable platform on said track between the first and second positions." As noted, *In re Oetiker* focuses on the problem with which the inventor(s)/applicant(s) are concerned. The problem with which applicants were concerned in the instant case was not "*to move each moveable platform on said track between the first and second positions* (emphasis added)." As previously noted, the problem *with which the applicants were concerned* was the "need to provide greater access to the coin receptacles contained within a coin redemption machine" (page 2, lines 30-31 of specification). Instead of focusing on the disclosed problem, the Examiner started the inquiry from the very claims themselves (*i.e.*, via the unmistakable reference to the "moveable platform on said track"), which focuses on the very solution arrived at by the inventors in solving their problem rather than focusing on the problem itself and natural inquiries arising therefrom. This is manifest error and merits withdrawal of the rejection in its own right.

Muellner is not pertinent to the problem of addressing a "need to provide greater access to the coin receptacles contained within a coin redemption machine," nor would it have reasonably commanded itself to the attention of one attempting to address such need. Muellner is non-analogous art for at least this reason. As previously noted, differences in classification is evidence of non-obviousness that must be considered by the Examiner. Muellner is primarily classified under U.S. Class 211. In contrast, Hino is primarily classified under U.S. Class 194. There is also no overlap in class/subclass. The fields searched by the respective Examiner's prosecuting these applications underscores the markedly different fields searched for each of

these references. The Examiner improperly dismisses this evidence. The fields searched by the respective Examiner's prosecuting the Hino or Jones and Muellner applications underscores the markedly different fields of endeavor. "A reference is reasonably pertinent if, even though it may be in a different field from that of *the inventor's* endeavor, it is one which, because of the matter with which it deals, *logically would have commended itself to an inventor's attention in considering his problem.*" *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)(emphasis added). It is worth highlighting that the inquiry of whether something would have logically commended itself to "an inventor's" attention in considering his problem reflects a different inventor than that (*i.e.*, "the inventor") noted in the preceding clause (*compare*, "the inventor" . . . "an inventor"). The test for determining whether a reference is "reasonably pertinent" is *not* whether the reference may have been considered analogous to the inventor, but rather to another confronting the same problem faced by the inventor. The Examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

## VI. CONCLUSION

It is the Applicants' belief that all of the claims are in condition for allowance and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247171-000390USPT.

Respectfully submitted,

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Date



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